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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,425	09/27/2001	Rui Saito	214375US0	8762

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/22/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/963,425

Applicant(s)

SAITO ET AL.

Examin r

Judy M. Reddick

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-23 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 and 9-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of the Group II invention/a) acrylic copolymer derived from n-butyl acrylate, 2-ethylhexylacrylate & acrylic acid, b) hydrogenated rosin ester & e) polyethylene terephthalate film in Paper No. 8(05/05/03) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Counsel is herein apprised that the indication of an ultimate species of component "e)" although acknowledged was not necessary since this species election applies to the Group III invention(claims 20-23) and nonelected. Claims 3-7 and 9-23 are withdrawn from consideration as per having been drawn to a nonelected invention.

Claim Objections

2. Claim 8 is objected to because of the following informalities: Claim 8 is dependent from a non-elected claim, viz., claim 3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Traynor et al(U.S. 4,726,982).

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Traynor et al disclose and exemplify pressure-sensitive adhesives and adhesive tapes, especially a tapes having a thick foam or foam like core and a relatively thin, dense, pressure-sensitive adhesive surface layer which has been selected to provide improved adhesion to specific surfaces. Specifically, Traynor et al teach that the pressure-sensitive adhesive comprises by weight a blend of (1) an acrylic copolymer of monomers comprising: (a) acrylic acid ester of nontertiary alkyl alcohol, the alkyl groups of which have an average of about 4 to 14 carbon atoms, said acrylic acid ester being per se polymerizable to a sticky, stretchable, elastic adhesive mass and (b) N-vinyl-lactam in an amount comprising from 10 to 40 parts of the total monomers (a) and (b), sufficient to meet the claimed acrylic polymer and (2) tackifier resin selected from at least one of poly(isobornylmethacrylate), mixed-aliphatic/aromatic polymeric tackifier resin and pentaerythritol ester of rosin(sufficient to meet the radiation-resistant agent per the claimed invention), and in an amount from about 5 to 50 parts per hundred parts of copolymer (1), said copolymer having a monomer conversion factor exceeding 95% and being crosslinked as evidenced by the adhesive having at least 50% gel in tetrahydrofuran (THF). More specifically, Traynor et al, per Run 1, describes a pressure sensitive adhesive comprising a copolymer or isooctyl acrylate/N-vinyl pyrrolidone and a tackifier resin A and an irradiated adhesive coating therefrom as follows: To a one-quart (1000-ml) narrow-mouthed glass bottle were added 135.0 g IOA, 45.0 g NVP, 0.36 g azobisisobutyronitrile ("Vazo".TM. 64), and 220 g ethyl acetate. The solution was purged with one liter per minute nitrogen to eliminate oxygen. The sealed bottle was tumbled in a rotating water bath at 55 degrees C for 24 hours to effect complete polymerization. The copolymer was diluted to 25% solids with toluene. The diluted copolymer had a measured viscosity of 17,900 centipoises and a measured inherent viscosity of 1.63 deciliters/gram. To 100 g of a 25%-solids solution of the copolymer in a clean glass bottle was added 5 g (i.e., 20 phr=parts per hundred copolymer), of pulverized Tackifier Resin A. After stirring with a metal spatula, this was allowed to stand overnight until the tackifier resin had dissolved in the solution. After stirring to insure uniform distribution of the tackifier, 0.8747 g of XL-1 was dissolved in 24.1273 g of toluene, and a portion of this solution was added to the bottle with stirring to provide 0.15% of the XL-1 based on total solids. This was stored in the dark to allow entrained air bubbles to clear. The resulting composition was knife-coated onto a release paper, and the coating was dried in an oven to a thickness of about 0.05 mm. The dried tackified pressure-sensitive adhesive coating was irradiated(sterilized) with an exposure of 360 mJ/cm.sup.2 ("Dynachem".TM. Radiometer Model 500) from a bank of

lamps, 90% of the emissions of which were between 300 and 400 nm with a maximum at 351 nm. By doing so, the tackified pressure-sensitive adhesive layer of this example became crosslinked, as evidenced by 70% gel in THF.

A portion of the pressure-sensitive adhesive layer of this transfer tape was transferred to a biaxially-oriented poly(ethylene terephthalate) polyester film backing 0.0375 mm in thickness, and another portion was transferred to a flexible polyurethane film backing 0.15 mm in thickness. See, e.g., the Abstract, and cols. 3-14, especially, Runs 1, 3-12, 21-27 and comparative Runs 13-19. Traynor et al therefore anticipate the instantly claimed invention with the understanding that while Traynor et al does not mention that the disclosed pressure sensitive adhesive tape may be used for medical purposes nor qualify the tackifying resins as "radiation resistant agents", the discovery of a new property or use for a previously known compound/composition cannot impart patentability to the claims, even if the property or use is unobvious from the prior art as provided for under the guise of *In re Schoenwald*(22 USPQ 1671). As to the "radiation-resistant" property, it would be expected that the pressure sensitive adhesive product of Traynor et al would possess this property since the pressure sensitive adhesive product of Traynor et al is essentially the same as and made in essentially the same manner as the claimed adhesive product. There is absolutely nothing viable on this record diffusing this issue.

As to the elected species, the interchangeability of one well known acrylic polymer and one well known rosin derivative for another would have been a matter of ordinary choice to the skilled artisan, absent some evidence of unusual or unexpected results. However, Applicants are reminded that the elected invention is not limited to the elected species.

Response to Arguments

6. Applicant's arguments filed 01/16/03 have been fully considered but they are not persuasive.

Relative to Traynor et al—The crux of counsel's arguments appear to hinge on there being no basis in fact and/or technical reasoning to reasonably support the determination that the "radiation-resistant" properties would necessarily flow from the composition of the prior art, viz., Traynor et al.

It is urged and maintained the radiation-resistant properties of the adhesive product, as claimed, would necessarily flow from the pressure sensitive adhesive product of Traynor et al since the product of Traynor et al is essentially the same as and made under essentially the same conditions as the claimed product. In any event, when the claimed compositions are not novel they are not rendered patentable by recitation of

properties, whether or not these properties are shown or suggested in the prior art as provided for under the guise of In re Spada(911 F. 2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). To this end, Counsel has the burden of establishing that the pressure sensitive adhesive products of Traynor et al do not possess the claimed radiation-resistant property as provided for under the guise of In re Best et al(195 USPQ 430) and/or In re Fitzgerald et al(205 USPQ 594). See the Office Action of paper no. 4, 10/17/02, paragraph no. 7.

Conclusion

7. *The rejection based on Hosokawa et al(U.S. 6,312,799) is herein withdrawn as per such being considered merely cumulative to the rejection supra based on Traynor et al. The additionally listed prior art to Moon et al(U.S. 4,988,742), Bernard et al(U.S. 5,130,375), Everaerts et al(5,695,837), Rothrum et al(U.S. 5,707,703), Wong et al(U.S. 5,876,855) and Lucast et al(U.S. 6,198,016 B1) is cited as of interest in teaching irradiated(sterilized) acrylic adhesives. A rejection, in the future, may be made based on said prior art but is not being made at this time since there is a viable rejection maintained on this record.*

8. *Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).*

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
July 20, 2003